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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,520	09/09/2003	Shigeaki Fukushima	6340-000039	1939

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EXAMINER

BINDA, GREGORY JOHN

ART UNIT PAPER NUMBER

3679

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/658,520

Applicant(s)

FUKUSHIMA ET AL.

Examiner

Greg Binda

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5 and 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

2. Claims 2 & 6 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant elected with traverse of Species I shown in Figs. 1-3. Applicant timely traversed the restriction (election) requirement in the reply filed on June 1, 2005.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the following claimed subject matter:
 - a. Claim 3, line 5: “a radially outwardly arranged member” in addition to the wheel hub 1
 - b. Claim 3, line 8: “a radially inwardly arranged member” in addition to the outer joint member 14.
 - c. Claim 3, lines 8 & 9: “outwardly expanding the radially inwardly arranged member”
 - d. Claim 5, line 2: “the outer joint member . . . is fitted onto the wheel hub”

Claim Rejections - 35 USC § 103

4. Claims 1 & 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sera et al. US 2002/0051597 (Sera). Fig. 7 shows a bearing apparatus for a driving wheel of a vehicle comprising: a wheel hub 80, a constant velocity universal joint 70 and a double row rolling bearing 23 assembled as a unit, the wheel hub and an outer joint part member 70 of the constant velocity universal joint are fitted with each other; and a connected portion of the wheel hub and the outer joint member has a plastic deformation mechanism 75. Sera does not expressly disclose that the axial pull-out force of the plastic deformation connection mechanism would be more than 160kN. However, it would have been obvious to one of ordinary skill in the art to design the bearing apparatus of Sera such that the axial pull-out force of the plastic deformation connection mechanism would be more than 160kN, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

5. Claims 1, 3-5 & 7-9 are rejected under 35 U.S.C. 103(a) as being obvious over any one of U. S. Patent Nos. 6,497,515; 6,773,165 and 6,780,114.

Each applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing dates of the references, each constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject

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matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Double Patenting

6. Applicant is advised that should claim 4 be found allowable, claim 5 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

7. Claims 1, 3-5 & 7-9 are directed to an invention not patentably distinct from claims 1-24 of commonly assigned US 6,497,515 and claims 1-16 of commonly assigned US 6,773,165. Specifically, it would have obvious to make the bearing apparatus in the patented claims so that it includes all the limitations of the bearing apparatus in the instant claims for the same reason noted in item 4 above.

8. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302).

Commonly assigned US 6,497,515, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

9. Claims 1, 3-5 & 7-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,497,515 and claims 1-16 of U.S. Patent No. 6,773,165. Although the conflicting claims are not identical, they are not patentably distinct from each other for the same reason noted in item 7 above.

Response to Arguments

10. Applicant's arguments filed October 11, 2005 have been fully considered but they are not persuasive.

a. In regard to items 3a-c, applicant argues that the noted limitations are supported in the detail description at paragraphs 51-53. However, there is no mention of features corresponding to those limitations in those paragraphs. Those paragraphs do not even describe the elected species.

b. In regard to item 4, applicant argues that it would not have been obvious to modify Sera in the way noted in the rejection because Sera discloses a method of plastic deformation that, due to the presence of an "inner ring", is different than that used in the instant invention. However, the argument is moot because in Fig. 7 (the figure noted in the rejection above), Sera shows a bearing apparatus that does not include an inner ring. (Note: Sera shows the inner ring 22 only in embodiments that are not relied upon in the rejection.)

c. In regard to item 5, applicant has attempted to disqualify cited patents, U. S. Patent Nos. 6,497,515; 6,773,165 and 6,780,114 under 35 U.S.C. 103(c) by showing that the instant invention was owned by, or subject to an obligation of assignment to, the same entity as the cited patents at the time this invention was made. However, applicant has failed to provide a statement that the application and the cited patents were owned by, or subject to an obligation of assignment to, the same person at the time the invention was made in a conspicuous manner, and therefore, is not disqualified as prior art under 35 U.S.C. 103(a). Applicant must file the required evidence in order to properly disqualify the cited patents under 35 U.S.C. 103(c). See MPEP § 706.02(l).

(In addition, applicant may overcome the applied art either by a showing under 37 CFR 1.132 that the invention disclosed therein was derived from the inventor of this

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application, and is therefore, not the invention “by another,” or by antedating the applied art under 37 CFR 1.131.)

d. In regard to item 6, applicant argues that the language of claims 4 & 5 is different. However, the difference in language, “into” and “onto”, in view of the specification, equates to no difference in meaning or interpretation. As such the claims are substantial duplicates thereof.

e. Applicant did not argue against the rejection at item 9.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Binda whose telephone number is (571) 272-7077. The examiner can normally be reached on M-F 9:30 am to 7:00 pm with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Greg Binda
Primary Examiner
Art Unit 3679